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Dated: July 26, 2004

Signature:

Shawn P. Foley
(Shawn P. Foley)

Docket No.:
RASMUS 9.0-001
(PATENT)



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Re Patent Application of:
Ole-Bendt Rasmussen

Application No.: 10/787,214

Confirmation No.:

Filed: February 27, 2004

Art Unit:

For: FOOD PRODUCT WHICH ARTIFICIALLY
HAS BEEN GIVEN A CELL-LIKE
STRUCTURE BY COEXTRUSION OF
SEVERAL COMPONENTS, AND METHOD
AND APPARATUS FOR MANUFACTURING
SUCH FOOD PRODUCT

Examiner:

Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

**PETITION UNDER 37 C.F.R. § 1.181, AND IN THE
ALTERNATIVE, 37 C.F.R. § 1.183 OR 37 C.F.R. § 1.137(A)**

Dear Sir:

This Petition is being directed to the Office of the Deputy Director for Patent Examination Policy pursuant to MPEP §1002.02(b), paragraphs 1, 2 and 27, and MPEP §506.02 and 711.03(c).

INTRODUCTION

The captioned patent application S.N. 10/787,214 ("the '214 Application") was submitted on February 27, 2004. It was intended to be a Continuing Prosecution Application (CPA) under 37 C.F.R. § 1.53(d) of the parent application S.N. 09/926,310 ("the '310 application"), the issue fee payment for which was due on March 1, 2004. The transmittal form submitted on February 27, 2004 (copy annexed hereto as Exhibit A) was entitled "REQUEST FOR FILING A

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CONTINUATION OR DIVISION OF AN INTERNATIONAL APPLICATION" (PTO/SB/13/PCT (08-03). Paragraph 11 on page 2 thereof contained a statement that was typed in by Applicant's attorney, requesting the Patent Office to "utilize the file wrapper and contents of prior SN 09/926,310, filed 10/11/01 and is currently pending & abandoned the latter as of this fi[ling]."

In a NOTICE OF INCOMPLETE NONPROVISIONAL APPLICATION, mailed May 24, 2004, (copy annexed hereto as Exhibit B), Applicant was informed that the captioned application failed to meet one or more requirements of 37 C.F.R. § 1.53(b), and would not be entitled to a filing date of February 27, 2004, because it did not contain a specification.

Applicant hereby petitions the Director of the U.S. Patent Office to accord a filing date of February 27, 2004 to the '214 Application (and along with it, the same application number as the parent). Such relief is believed to be properly grantable either under Rule 181, or, in the alternative, under Rule 183. In the alternative, Applicant hereby petitions the Director pursuant to Rule 137(a) to revive the '310 application solely to allow Applicant to file a CPA application. In the event that the Director were to grant this alternative petition, Applicant would immediately file the CPA and then, consistent with his intention as of February 27, 2004, expressly abandon the '310 application.

Applicant respectfully submits that this petition is timely filed¹ pursuant to 37 C.F.R. § 1.181(f) and 137(e). In addition, Applicant authorizes the Director to charge the requisite fees pursuant to 37 C.F.R. § 1.17(h) and (l), to Deposit Account No. 12-1095. Further enclosed are Declarations by Applicant, Ole-Bendt Rasmussen, and by William J. Daniel, Esq., the attorney

¹Since the two-month response date for the NOTICE OF INCOMPLETE NONPROVISIONAL APPLICATION, mailed May 24, falls on a Saturday, this submission is believed to be timely under Rule 181 (f). See also, ¶4 of the Daniel Declaration, which indicates that Mr. Daniel only became aware of the problem when he received the NOTICE. Regarding Rule 137(e), Applicant has not yet received a Notice of Abandonment in connection with the '310 application.

who submitted the '214 Application, Powers of Attorney authorizing the undersigned to act on Applicant's behalf in connection with both the '214 and the '310 applications, a completed form PTO/SB/61 ("PETITION FOR REVIVAL OF AN APPLICATION FOR PATENT ABANDONED UNAVIDABLY UNDER 37 CFR 1.137(a)"), and an executed copy of the NOTICE OF ALLOWANCE AND FEE(S) DUE, in connection with the '310 application, authorizing the Director to charge Deposit Account No. 12-1095 in the amount of the issue fee.

STATEMENT OF FACTS

Application No. 09/926,310 ("the '310 application") was the national stage of PCT EP 00/03713, ("the PCT application") filed April 13, 2000². The PCT application was published on October 19, 2000, bearing International Publication No. WO 00/60959.

A Notice of Allowability and NOTICE OF ALLOWANCE AND FEE(S) DUE in connection with the '310 application were mailed on December 1, 2003. Thus, the non-extendable date for payment of the issue fee was March 1, 2004. On February 12, 2004, Applicant's attorney, William J. Daniel (Reg. No. 16,585), submitted an amendment pursuant to 37 C.F.R. § 1.312 (Rule 312). On February 24, the Examiner informed Mr. Daniel that she decided not to enter the amendment. On February 27, 2004, the '214 application was submitted. Mr. Daniel intended the '214 Application to be a CPA of the '310 application pursuant to Rule 53(d). Daniels Decl., ¶3. Since the '310 application was a national stage entry of a PCT application filed on or before May 29, 2000, a CPA was proper pursuant to Rule 53(d)(i)(C). The transmittal form that Mr. Daniel used for to effect such filing (Exh. A) was entitled "REQUEST FOR FILING A CONTINUATION OR DIVISION OF AN INTERNATIONAL APPLICATION" (PTO/SB/13/PCT (08-03)). As discussed below, the first paragraph of the form contained a preprinted paragraph referring to 37 CFR 1.53(b). Paragraph 11 on page 2 thereof

² The national stage entry date under 35 U.S.C. 371(c) was October 11, 2001. The PCT Application claims priority from GB Application Nos. 9908444.4, filed April 13, 1999, and 9912565.0, filed May 28, 1999.

contained a statement that was typed in by Applicant's attorney, requesting the Patent Office to "utilize the file wrapper and contents of prior SN 09/926/310, filed 10/11/01 and is currently pending & abandoned the latter as of this fi[ling]."

The NOTICE OF INCOMPLETE NONPROVISIONAL APPLICATION (Exh. B) was mailed on May 24, 2004, in connection with the '214 application. It indicated that the '214 Application failed to meet one or more requirements of Rule 53(b), because the specification was missing from the original submission of February 27, 2004, and as a consequence, the '214 application would be granted a filing date corresponding to the date on which the Office received said specification.

ARGUMENT

The Patent Office has already determined that the '310 application contained a patentable invention. Applicant, through Mr. Daniel, allowed that application to go abandoned conditioned on his understanding and belief that the '214 application would receive the filing date of February 27, 2004, and that prosecution could be continued through the '214 application. If the '214 application is not granted a filing date of February 27, 2004, co-pendency with the '310 application is severed, and Applicant's published PCT application becomes prior art to the '214 application under 35 U.S.C. § 102(b). Basically, Applicant will have lost his patent rights.

Mr. Daniel intended to file the '214 application as a Rule 53(d) CPA. Daniel Decl. ¶¶3-4. Ideally, he should have used the form suggested by the Office to effect this filing. Instead, he mistakenly used a transmittal form intended for a different purpose. Daniel Decl. ¶3. The preprinted form included a statement that "This is a request for filing a [] continuation [] divisional application under 37 CFR 1.53(b)" (Exh. A, first page). Mr. Daniel edited the form as actually submitted to contain other indications required by Rule 53(d) (Exh. A, second page, ¶11), but did not change the preprinted statement to read "53(d)" instead of "53(b)".

Despite the confusion caused by this error, it is believed that the resulting transmittal form as actually submitted (Exh. A), when taken as a whole, met the requirements of Rule 53(d) and reflected Mr. Daniel's intent to file the '214 application as a CPA.

Rule 53(d)(1)(i)(C) is clearly met; the prior ('310) application was a national stage of an international application filed before May 29,2000, and was in compliance with 35 U.S.C. 371. The transmittal form met the requirements of Rule 53(d)(1)(ii)(A) in that it was filed before abandonment of the '310 Application (the issue fee was due March 1, 2004).

The transmittal form identified the prior application, i.e., the '310 application; it included a request for the '214 application to utilize the file jacket and contents of the '310 application; and it requested the abandonment of the '310 application as of the filing date. Thus, the requirements set forth in Rule 53(d)(2)(i)-(v), are also satisfied. As to identity of inventorship with the prior application (Rule 53(d)(2)(iii)), a declaration copy was referred to in the transmittal form (Exh. A, ¶8); the declaration (copy annexed hereto as Exhibit C) identified the same sole inventor (Mr. Rasmussen) as named in the prior ('310) application. The transmittal form indicates that a check in the amount of \$1,042.00 was enclosed, and further authorized the Director to charge fees due to a deposit account (Exh. A, ¶3). Thus, the requirement of Rule 53(d)(3) is also satisfied.

Again, Applicant acknowledges, and apologizes for, the confusion resulting from Mr. Daniel's use of an incorrect form and by the explicit reference to "37 C.F.R. 1.53(b)" in the preprinted first paragraph of the form. However, the explicit, manually-typed instruction to "utilize the file wrapper and contents" of the prior application indicated that a Rule 53(d) filing was intended; Rule 53(d) was the normal Office procedure under which the file wrapper and contents of a prior application would be used. Taken as a whole, therefore, the transmittal form

expressed a request to proceed under Rule 53(d). Further, such request was set forth in a "separate paper" as required by Rule 53(d)(2).

Applicant respectfully requests the Director to hold that the '214 Application papers as originally submitted on February 27, 2004 constituted a proper request for filing of a Continued Prosecution Application utilizing the file jacket and contents of the '310 application, as a continuation of the '310 Application, and to accord such Continued Prosecution Application a filing date of February 27, 2004.

In the alternative, if the Director finds that the '214 application papers as originally submitted did not meet one or more requirements of Rule 53(d) which is not a requirement of the statute, it is respectfully requested that the Director waive such requirement pursuant to Rule 183. Applicant respectfully submits that the facts discussed above constitute an "extraordinary situation" in which the Director should suspend or waive a requirement of the regulations so as to avoid an manifestly unjust forfeiture. Again, the Office has already determined that there is a patentable invention. Patent rights to such invention will be lost if the '214 application does not receive the February 27, 2004 filing date. Any failure to comply with the procedural rules for filing a CPA clearly occurred inadvertently, despite a good-faith effort by Mr. Daniel and Applicant to comply with such rules in a timely fashion to secure Applicant's rights by way of a continuation application filing. Any failure to meet the requirements of Rule 53(d) arose from Mr. Daniel's inadvertent use of the wrong transmittal form for the type of continuation application that he intended to file. In these circumstances, forfeiture of Applicant's patent rights would constitute a disproportionate and unduly harsh penalty, given the nature of and the honesty with which the mistake was made.

In the alternative, if the Director should hold that the '214 Application as submitted must be treated as an application filed under Rule 53(b) rather than Rule 53(d), it is respectfully

submitted that the '214 Application as submitted met the requirements for filing a continuation application pursuant to 37 C.F.R. § 1.53(b). The specification, claims and drawings were not an actual physical part of the documents submitted on February 27, 2004. Nonetheless, Applicant respectfully submits that Rule 53(b) was satisfied because the specification, claims and drawings, were in fact, present due to their incorporation by reference. If the direction in the transmittal form as submitted to "utilize the file wrapper and contents" of the '310 Application (Exh. B, ¶11) is not construed as a direction to proceed under Rule 53(d) (*supra*), the only other plausible meaning of that direction would be a direction to incorporate such papers in a newly-filed 53(b) application, *i.e.*, an incorporation by reference. There is no ambiguity as to what the content of the new application would include. Thus, the statutory requirement for a specification, claims and drawings has been met. Even if the '214 Application is treated under Rule 53(b), it should be accorded the filing date of February 27, 2004. Here again, if the Director should find that a requirement under Rule 53(b) not mandated by statute has not been complied with, such requirement should be waived in the interests of justice under Rule 183.

Finally, if none of these requests is granted, Applicant hereby requests the Director pursuant to Rule 137(a), to revive the '310 application, on the ground that his failure to pay the issue fee by March 1, 2004 was unavoidable. Applicant believed and understood that he was foregoing an issued patent at the time in order to continue prosecution without any loss of rights whatsoever. In other words, he was agreeable not to pay the issue fee and to expressly abandon the '310 application on one and only one condition -- that his patent rights were preserved. Likewise, Applicant's attorney Mr. Daniels took a course of action that he believed would be consistent with and properly serve his client's interests; he acted and made a timely submission to ensure that pendency between the '310 and '214 applications was maintained. Surely, no such action would have been taken in connection with the '310 application (*i.e.*, to direct the Office to

abandon the '310 application as of the filing of the '214 application) had Applicant or his attorney respectively appreciated that patent rights would have been lost or that pendency would have been severed. On the basis of these facts, Applicant submits, therefore, that abandonment of the '310 application was unavoidable.

The Declarations by Applicant and his attorney do evince an intent to continue prosecution rather than have the '310 application issue. Therefore, consistent with that intent, if the Director grants this petition and revives the '310 application, Applicant will file a CPA and immediately thereafter, expressly abandon the '310 application.

The consideration given to this submission is appreciated.

Dated: July 26, 2004

Respectfully submitted,

By Shawn P. Foley
Shawn P. Foley
Registration No.: 33,071
LERNER, DAVID, LITTENBERG,
KRUMHOLZ & MENTLIK, LLP
600 South Avenue West
Westfield, New Jersey 07090
(908) 654-5000
Attorney for Applicant